

**REMARKS/ARGUMENTS**

This amendment is submitted in response to the Advisory Action before the Filing of an Appeal Brief dated August 25, 2005. Reconsideration and allowance are requested.

Claims 1-10 remain in this application.

Counsel for assignee thanks the Examiner for the telephone discussion of September 15, 2005 where the comments in the Advisory Action were discussed.

***Claim Rejection Under 35 USC 102***

In the Advisory Action, claims 1-3 and 5 stand rejected under 35 USC 102(e), as being anticipated by Sawanobori et al. (US Patent # 5,936,668). Counsel for assignee respectfully traverses. Establishing anticipation under 35 USC § 102 requires that "each and every element of the claimed invention be disclosed in a prior art reference..." *Akzo v N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986) cert. denied, 482 U.S. 909 (1987). Sawanobori does not teach each and every element of claim 1 for the reasons argued in the previous response to Office Action. Nevertheless, in an effort to further distinguish claim 1 from Sawanobori, counsel for assignee has amended claim 1 to include storing the new image in a memory located within the electronic camera.

Since the Examiners pointed out in the Advisory Action that that the storage of the corrected image is not found in claim 1 and counsel has amended claim 1 to include this limitation, counsel respectfully requests that the Examiner reconsider this rejection in light of this amendment. Additionally, and as previously argued by the Applicants, Sawanobori does not teach or suggest to store the new image in a memory located within the electronic camera, in any way. In Figure 6 and column 5, lines 50-64, Sawanobori describes the processing of the image signal output through the white balance controlling circuits for display on the LCD and not as claimed. Therefore, under *Akzo* claim 1 is not anticipated by Sawanobori because at a minimum Sawanobori does not teach storing the new image as claimed.

For these reasons as well as the reasons argued in the previous responses to Office Actions, claim 1 is allowable. Additionally, claims 2, 3, and 5 are dependent from claim 1 and are allowable for at least the same reasons mentioned above.

***Claim Rejection Under 35 USC 103***

In the Advisory Action, claim 4 stands rejected under 35 USC 103(a) as being unpatentable over Sawanobori et al. (US Patent # 5,936,668) in view of Vogel (US Patent # 5,668,596) and claims 6-10 stand rejected under 35 USC 103(a) as being unpatentable over Sawanobori et al. (US Patent # 5,936,668) in view of Sakaguchi (US Patent # 5,534,916). For reasons presented in the previous office action counsel does not believe that the cited prior art teach all of the claimed limitations. Nevertheless, in an effort to further distinguish the claims from the cited prior art, counsel for assignee has amended claim 1, as well as claims 4 and 6-10 through their dependency on claim 1, to include storing the new image in a memory located within the electronic camera. In light of this amendment, counsel believes that claims 4, and 6-10 are allowable.

***Claim Rejection Under 35 USC 103(a) Using Inherency***

The Examiner also relied upon the theory of inherency to reject claim 4. In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See MPEP 2112.

First, the Examiner stated that "column 5, lines 55-61; and figure 3: 34; the first correction control section is considered to correct white balance, and in order for the device to operate the white balancing property there is a clock that is inherent." The Examiner's position that it is inherent that the a first correction control section for sequentially generating a luminance...on the basis of a clock signal synchronized with each luminance information in the image signal, is not legally supported because the inherent characteristic **does not** necessarily flow from the teachings of the applied prior art. The Examiner is asserting that just because a

clock exists then a clock signal which can be synchronized with each luminance information in the image signal must necessarily be a basis for the first correction control section for sequentially generating a luminance and is ignoring the possibility that something else could be used as the basis which is not the clock. Vogel does not mention using the clock in this matter and there is no reason to suspect that he must necessarily do so.

Second, the Examiner stated that "(figure 3: 34 and 50; the synthesized gain that is a product of the first and second correction amount is inherently present because they are both used together in order to adjust the image to be output." The Examiner's position that it is inherent that the product of the first and second correction amount is present in the synthesized gain, is not legally supported because the inherent characteristic does not necessarily flow from the teachings of the applied prior art. The Examiner is asserting that just because both a first and second correction amount is used then they must be used together as a product in order to adjust the image to be output and is ignoring the possibility that they are not used together as a product, such as for example using one instead of the other. Again, Vogel does not mention using a synthesized gain that is a product of the first and second correction amount and there is no reason to suspect that he must necessarily do so.

Therefore, in light of these remarks and the amendments made to claim 1, which claim 4 depends from, counsel respectfully requests that this rejection relying on inherency be withdrawn and that claim 4 be allowed.

The Examiner also relied upon the theory of inherency to reject claim 8. In rejecting claim 8 the Examiner stated "it is inherent that the correction amounts represent two correction distribution characteristics changing in axial directions because the correction amount is dependent on the pixel position." The Examiner's position that it is inherent that the correction amounts represent two correction distribution characteristics changing in axial direction, is not legally supported because the inherent characteristic does not necessarily flow from the teachings of the applied prior art. The Examiner is asserting that just because the correction amount is dependent on the pixel position and a pixel can have two coordinates then the correction amounts represent two correction distribution characteristics changing in axial directions and is ignoring

the possibility that correction distribution depends on another feature such as color. Sakaguchi does not mention a correction distribution dependency and there is no reason to suspect that he must necessarily have one like this.

The Examiner also relied upon the theory of inherency to reject claims 9 and 10. In rejecting claims 9 the Examiner stated "it is inherent that the correction amounts represent two correction distribution characteristics changing in axial directions because the correction amount is dependent on the pixel position, and it is implied that if the two correction amounts are dependent on the position on each axis that if the values increased as it moved outward, the sum of the two would increase the correction amount based on position." The rejection of claim 10 is identical to the rejection of claim 9 except that the word "sum" has been exchanged with the word "product." The arguments used above to counter the inherency rejection of claim 8 applies here as well.

Moreover, it appears that the Examiner is concluding that the limitation wherein the luminance correction generates and uses sums or products of two obtained axial luminance correction values as the luminance correction amounts corresponding to the pixels is implied because if the two correction amounts are dependent on the position on each axis that if the values increased as it moved outward, the sum or products of the two would increase the correction amount based on position. If counsel's understanding is correct then this rejection based on a theory of "implied" is traversed because it is improper. Nevertheless, counsel does not believe that generating and using sums or products is implied, obvious or inherent because there are many different mathematical functions that could be used instead. Counsel respectfully requests that based on these comments that this rejection be reconsidered.

Therefore, in light of these remarks and the amendments made to claim 1, which claims 8-10 depends from, counsel respectfully requests that this rejection relying on inherency be withdrawn and that claims 8-10 be allowed.

Appl. No. 09/511,408  
Preliminary Amdt. dated September 29, 2005  
Reply to Final Office Action of Nov. 30, 2004  
and Advisory Action of August 25, 2005

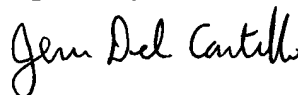
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**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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